



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/649,463

08/26/2003

David T. Zwolinski

85939.000292

5382

23387

7590

02/09/2006

Stephen B. Salai, Esq.

Harter, Secrest & Emery LLP

1600 Bausch & Lomb Place

Rochester, NY 14604-2711

EXAMINER

PICKARD, ALISON K

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,463	ZWOLINSKI ET AL.	
	Examiner	Art Unit	
	Alison K. Pickard	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 and 40-46 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 44 is rejected under 35 U.S.C. 102(b) as being anticipated by Arima (5,124,189).

Arima discloses a weather seal comprising a sealing surface defined by a first cellular portion R2 and a second cellular portion R3, which is different from the first.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-38, 40-43 and 46 rejected under 35 U.S.C. 103(a) as being unpatentable over Saint-Louis Augustin (5,005,317) in view of Bova.

Saint-Louis Augustin discloses a weather seal with a seal portion 31 formed of a polymeric material. An outer sealing surface is defined by two, different materials 31 and 37. The second material 37 is formed in strips, bands, random patterns, is projecting, and is flush (at tip). Saint-Louis Augustin does not disclose that the second material 37 is a freeze release material and does not appear to specifically disclose the seal is cellular. Bova teaches a weather seal. Bova teaches forming a sealing surface of the seal with two materials, one being a freeze

Art Unit: 3673

release material, the other being cellular. Bova teaches various materials (including thermosets and thermoplastics) for both portions that cooperate well together (see col. 3, line 65 through col. 4 line 45). The freeze release material can also include particles (col. 3, lines 3-34). Bova teaches using the freeze release material to improve the seal with a desired freeze release and coefficient of friction. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the weather seal with the materials taught by Bova to produce an improved seal with desirable freeze release and friction properties.

Regarding claims 14 and 25, making the freeze release area between $1/3$ to $2/3$ of the sealing surface area is considered a design choice. It is not considered inventive to discover the workable or optimum ranges by routine experimentation. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the freeze release area between $1/3$ to $2/3$ of the sealing surface area as a matter of choice in design.

Regarding claims 4, 32, and 46, making the sealing portion a bulb is considered a design choice. See *In re Dailey*, 149 USPQ 47 (CCPA 1966). Further, it is known that weather seals can have a finger-like or bulb sealing portion as evidenced by Nozaki '029. And, it appears that either shape performs equally as well. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the sealing portion a bulb.

5. Claims 6 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Augustin in view of Bova as applied to claims 1 above, and further in view of Miyakawa (5,441,685).

Saint-Louis Augustin does not disclose the material is flush with the cellular portion at the contact portion. Miyakawa teaches a weatherseal comprising a sealing portion with a

Art Unit: 3673

coating. Miyakawa teaches the coating 10 can be applied in a projecting or flush manner (Figs. 3 and 4). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the freeze release material flush with the cellular portion as such is an art equivalent arrangement as taught by Miyakawa.

6. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arima.

Arima does not appear to disclose the materials are polymeric. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the materials polymeric.

Allowable Subject Matter

7. Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 10-12-05 have been fully considered but they are not persuasive.

Regarding the arguments about the seal having cellular material, it is important to note that claim 21, for example, does not require cellular material. Regardless, Bova not only teaches the use of a freeze release material, but also teaches that the main seal body is made of a cellular material. Bova teaches specific materials that cooperate well together. Further, it is known that the body of a weatherseal can be made of a cellular material as evidenced by Nozaki, Guillon, or Willett. Saint-Louis Augustin also discloses the seal can be made of varied materials with varied

Art Unit: 3673

hardnesses. Using a cellular material would provide the necessary strength to maintain shape while providing good bond with the skin portion.

Regarding the arguments that St. Louis teaches away from material 31 touching the window, the examiner disagrees. The purpose of material 37, which is clearly applied in a spaced apart manner to 31, is to reduce friction. If the purpose of the material were to prevent the material 31 from ever possibly touching the glass, it would not be provided in a fractioned matter. If it were unacceptable for material 31 to contact the glass, the coating 37 would be put on every possible portion that might ever potentially contact the glass. However, this is not the case. Further, Guillon, EP '341, EP' 989, and Miyakawa '685 show friction coatings provided in spaced strips. Clearly, it is an acceptable and known practice to use spaced coatings, thus allowing the potential/probability that the base material will contact the glass. Further, Miyakawa's Figure 3 shows a freeze-release coating 10 in a flush relationship with the material of lips 3. Clearly, a portion of the material of the lips will contact the glass. (NOTE: this reference could be modified with a teaching of a cellular material to provide the claimed weatherseal.) Therefore, the examiner submits that the combination produces the claimed invention and both materials would contact the glass as required by the claims. The claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding the arguments against Bova, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the

Art Unit: 3673

references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Further, Bova could be modified with St. Louis or Guillon in that both teach making a coating spaced/fractioned to provide flexibility.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alison K. Pickard
Primary Examiner
Art Unit 3673

AP